

REMARKS

Amendments

Claims 1-12, 14-16, 18, 19, 21, and 22 are amended to use language in accordance with conventional US practice, to delete superfluous language and/or to correct obvious errors in grammar and punctuation. These amendments do not narrow the scope of the claims. In addition, the claims are amended to expressly recite substituents for various claim terms such as alkyl. These amendments are supported throughout the disclosure. See, e.g., page 21, line 11 - page 23, line 28.

New claim 23 is directed to further aspect of the invention and is supported throughout the disclosure. See, e.g., page 6, line 4 - page 10, line 23 and the Examples.

Election

In response to the Restriction Requirement, applicants hereby elect Group I, drawn to thienylpiperidine compounds and compositions, in which W is not a nucleoside. Claims 1-9, 18, and 23 read on the elected subject matter. However, the Restriction Requirement is respectfully traversed.

The Restriction between Groups I and II seeks to restrict within a single claim, e.g., claim 1. Applicants respectfully submit that 35 USC §121 does not permit restriction within a single claim as clearly indicated by the court in *In re Weber et al.*, 198 USPQ 328 (1978).

As a general proposition, an applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits.

It is apparent that §121 provides the Commissioner with the authority to promulgate rules designed to *restrict* an *application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular claim on that same basis. [*Weber* at 331-332]

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The effect of restriction within a single claim is the same as a rejection. 35 USC §121 does not give the Commissioner authority to require that a single claim "be divided up and presented in several applications" and thus deny the Applicant the right to have that single claim considered on its merits. This is exactly the action that the Court in *Weber* stated was not permitted under 35 USC §121. Such action by an Examiner would violate "the basic right of the Applicant to claim his invention as he chooses." [*Weber* at 332]

The claims here are Markush claims. MPEP §803, entitled "Restriction - When Proper," states that "[i]nsofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria are set forth in MPEP §803.02." The latter section of the MPEP states that: "[s]ince the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention."

Thereafter, the MPEP cites *In re Harnish*, 206 USPQ 300 (CCPA 1980) and *Ex parte Hozumi*, 3 USPQ2d (Bd. Pat. App. & Int. 1984). These two cases both deal with improper Markush rejections. Thus, in the case of Markush claims, refusal by the Office to examine that which the applicants regard as their invention must be a refusal based on an improper Markush rejection. No such rejection has been made.

In view of the above remarks, examination as to Groups I and II should proceed in accordance with MPEP §803.02.

With respect to Group V, these claims merely recite an additional component. The search required for examination of this Group necessarily encompasses the entire search required for elected Group I and Group II. Moreover, once the compounds of Group I and/or Group II are found to be allowable, a composition or combination encompassing such compounds will also necessarily be allowable, regardless of any additional component. The assertion that the additional ingredient may have an additive, synergistic or antagonistic effect does not impact the scope of the search or the examination. Thus, withdrawal of the Restriction between Group I and Group V (as well as Group II if this Group is combined with Group I as a result of the procedure in MPEP §803.02) is respectfully requested.

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As for Groups III-IV, upon determination that the subject matter of Group I (and possibly Group II) is allowable, applicants will request rejoinder of the claims of Groups III-IV, pursuant to MPEP §821.04. Further, if the Restriction is withdrawn as to Group V, applicants will request rejoinder of the claims of Group VI, pursuant to MPEP §821.04.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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